

Appl. No. : 10/642,952
Filed : August 18, 2003

REMARKS

Entry of the previous amendments which were not entered in the Advisory Action has been requested. This response is in addition to the previous amendments. Applicant respectfully requests reconsideration of the application in view of the amendments and the following remarks.

Response to the Advisory Action

The Examiner asserts:

“the Examiner is not persuaded that the catalyst of Imata et al. (JP 03056433) necessarily contains sodium oxide, especially since Imata et al. do not disclose that the catalyst contains sodium oxide and the catalyst disclosed in the Applicants declaration, filed December 20, 2004, is not described as being the catalyst disclosed in Imata et al.”

The only evidence that the Examiner relies on for asserting that the catalyst of Imata et al. contains no sodium oxide is that Imata et al. do not state that the catalyst contains sodium oxide. Although the Examiner also points out that the Applicants declaration, filed December 20, 2004, is not described as being the catalyst disclosed in Imata et al., the reason that the Applicants did not so describe is that Imata et al. do not provide sufficient information to identify the catalyst used in Imata et al. Imata et al. do not identify any trade name or product name of the catalyst or do not identify the exact starting material and the process in a way that one of ordinary skill in the art could trace the process and obtain the catalyst of Imata et al. Imata et al. do not provide any specific enabling information to reproduce or obtain the catalyst, and the Examiner unfairly uses the fact against Applicant. In any event, the only evidence that the Examiner relies on for asserting that the catalyst of Imata et al. contains no sodium oxide is that Imata et al. do not state that the catalyst contains sodium oxide.

37 C.F.R. § 1.104(c)(2) prescribes:

“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”

Accordingly, the Examiner is required to show the particular part of the reference. The fact that Imata et al. do not mention sodium oxide cannot be a fair basis for asserting that the catalyst contains no sodium oxide.

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (Emphasis added.) See also M.P.E.P. 2121.01. No indication of sodium oxide in Imata et al. cannot fairly be treated as a showing that Imata et al. show in complete detail that the catalysis contains no sodium oxide.

Further, the present specification states:

"This publication [JP-A-01-160933 (1989)] has described that a catalyst used in the process for producing DME is a γ -alumina catalyst, preferably a pure γ -alumina catalyst having lower impurity contents, i.e., 0.3 % or less of silica, 0.03 % or less of iron oxides and 0.10 % or less of sodium oxides and having a surface area of 150 to 300 mm²/g." (page 3, lines 6-12) (Emphasis added.)

"The publication [JP-A-02-085224 (1990)] has described that in terms of the catalyst used in the process for producing DME, a content of the metal oxide added is in the range of 0.005 to 80 wt%, preferably 0.5 to 20 wt% to the total weight of the catalyst; the pure alumina used is preferably γ -alumina having lower impurity contents, i.e., 0.3 % or less of silica, 0.03 % or less of iron oxides and 0.1 % or less of sodium oxides and having a surface area of 100 to 700 m²/g." (page 3, line 23 to page 4, line 4) (Emphasis added.)

"An example of a high purity alumina as a starting material for a γ -alumina catalyst is CATAPAL B (Brand Name) available from CONDEA Ltd. It is preferable to wash γ -alumina with an acid for reducing the amount of sodium oxides in the γ -alumina catalyst. However, as long as an average pore radius described below can be achieved and the amount of sodium oxides can be reduced, any other known technique may be applied than acid-washing. In order to reduce sodium oxides content in the catalyst, it is possible to remove sodium oxides from the starting material or from the shaped catalyst. Acid-washing may be conducted at an appropriate stage, depending on the type or production process of a starting γ -alumina and a level of removing sodium oxides. The content of sodium oxides in an activated alumina catalyst other than a γ -alumina catalyst may be similarly reduced, for example, by washing with an acid." (page 9, lines 10-26) (Emphasis added.)

The above clearly shows that conventionally, the catalysts naturally contain impurities such as sodium oxides. Imata et al. completely fail to recognize importance of the content of sodium oxides and thus make no mention of sodium oxide. Imata et al.'s silence regarding sodium oxide

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cannot be sufficient to conclude that the catalyst contains no sodium oxide. The Examiner is required to show in complete detail where Imata et al. teach that the catalyst contains no sodium oxide.

Applicant respectfully requests withdrawal of all the rejections.

CONCLUSION

In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.


Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 29, 2006

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